UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,489	04/19/2001	Leif Linde	64645-1048	8950

27045	7590	09/23/2004

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR C11
PLANO, TX 75024

EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/838,489	LINDE, LEIF
Office Action Summary	Examiner	Art Unit
	DANIEL LASTRA	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 June 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-41_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-41_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date   6/28/04 ; 11/23/04 .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-41 have been examined. Application 09/838,489 (METHOD AND

SYSTEM FOR DISTRIBUTING TARGETED ADVERTISING) has a filing date

04/19/2001.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 1-15 are not within the technological

arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave

Congress the power to "[p]romote the progress of science and useful arts, by securing

for limited times to authors and inventors the exclusive right to their respective writings

and discoveries".   In carrying out this power, Congress authorized under 35 U.S.C.

§101 a grant of a patent to "[w]hoever invents or discovers any new and useful process,

machine, manufacture, or composition or matter, or any new and useful improvement

thereof."   Therefore, a fundamental premise is that a patent is a statutorily created

vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

promote the progress of "science and the useful arts".   The phrase "technological arts"

has been created and used by the courts to offer another view of the term "useful arts".

See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970).   Hence, the first test of

whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within

the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 1 and 15 recite a "useful, concrete and tangible result" (a method for distributing a promotion), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 2-14 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et

al (U.S. 6,571,279).

As per claim 1, Herz teaches:

A method for distributing a promotion comprising the steps of:

selecting one or more subscribers to receive the promotion based on target

subscriber information associated with the promotion and subscriber information

associated with each subscriber (see column 7, lines 1-15; column 8, lines 51-55;

column 17, line 34 – column 18, line 22);

obtaining subscriber delivery information for each of the selected subscribers

(see column 6, lines 60-67; column 8, lines 51-55; column 17, line 34 – column 18, line

22); and

distributing the promotion to each of the selected subscribers based on the

subscriber delivery information for the selected subscriber (see column 8, line 51-65;

column 17, lines 35-55).

As per claim 2, Herz teaches:

The method as recited in claim 1 wherein the target subscriber information

comprises one or more target preference categories and a target interest level

associated with each target preference category (see column 6, lines 16-33; column 17,

lines 34-55).

As per claim 3, Herz teaches:

The method as recited in claim 1 wherein the subscriber information comprises one or more preference categories and a subscriber interest level associated with each preference category (see column 17, lines 35-55).

As per claim 4, Herz teaches:

The method as recited in claim 1 wherein the target subscriber information comprises target non-sensitive demographic information (see column 17, lines 35-55).

As per claim 5, Herz teaches:

The method as recited in claim 1 wherein the subscriber information comprises non-sensitive demographic information about the subscriber (see column 7, lines 40-52; column 17, lines 34-55).

As per claim 6, Herz teaches:

The method as recited in claim 1 wherein the subscriber delivery information comprises a receiving device type and a receiving device address (see column 7, lines 1-54).

As per claim 7, Herz teaches:

The method as recited in claim 1 wherein the subscriber delivery information comprises an acceptable time period to receive the promotion (see column 11, lines 50-60).

As per claim 8, Herz teaches:

The method as recited in claim 1 wherein the subscriber delivery information comprises a maximum number of promotions to be received within a specified time period (see column 11, lines 10-60).

As per claim 9, Herz teaches:

The method as recited in claim 1 'further comprising the step of receiving feedback from the selected subscribers (see column 16, lines 21-35; column 18, lines 5-55).

As per claim 10, Herz teaches:

The method as recited in claim 1 further comprising the steps of:

receiving a request to distribute the promotion (see column 8, lines 51-65); and

retrieving the promotion and the target subscriber information (see column 17, lines 34-55).

As per claim 11, Herz teaches:

The method as recited in claim 1 wherein the step of selecting one or more subscribers comprising the steps of:

retrieving the subscriber information for the subscriber (see column 8, line 51 – column 9, line 10; column 17, lines 34-65); and

selecting the subscriber when a comparison of the target subscriber information to the subscriber information for the subscriber satisfies one or more rules (see column 17, lines 34-65).

As per claim 12, Herz teaches:

The method as recited in claim 11 further comprising the step of repeating the steps of retrieving the subscriber information and selecting the subscriber until the one or more subscribers are selected (see column 17, lines 34-65).

As per claim 13, Herz teaches:

The method as recited in claim 1 wherein the step of obtaining subscriber delivery information further comprises the steps of requesting the subscriber delivery information for each selected subscriber using a subscriber identification for each selected subscriber and receiving the subscriber delivery information (see column 17, lines 34-65).

As per claim 16, Herz teaches:

A computer program embodied on a computer readable medium for distributing a promotion comprising:

a code segment for selecting one or more subscribers to receive the promotion based on target subscriber information associated with the promotion and subscriber information associated with each subscriber;

a code segment for obtaining subscriber delivery information for each of the selected subscribers; and

a code segment for distributing the promotion to each of the selected subscribers based on the subscriber delivery information for the selected subscriber. Claim 16 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 17, Herz teaches:

The computer program as recited in claim 16 wherein the target subscriber information comprises one or more target preference categories and a target interest level associated with each target preference category. Claim 17 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 18, Herz teaches:

The computer program as recited in claim 16 wherein the subscriber information comprises one or more preference categories and a subscriber interest level associated with each preference category. Claim 18 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 19, Herz teaches:

The computer program as recited in claim 16 wherein the target subscriber information comprises target non-sensitive demographic information. Claim 19 contains the same limitations as claim 4 therefore the same rejection is applied.

As per claim 20, Herz teaches:

The computer program as recited in claim 16 wherein the subscriber information comprises non-sensitive demographic information about the subscriber. Claim 20 contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 21, Herz teaches:

The computer program as recited in claim 16 wherein the subscriber delivery information comprises a receiving device type and a receiving device address. Claim 21 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 22, Herz teaches:

The computer program as recited in claim 16 wherein the subscriber delivery information comprises an acceptable time period to receive the promotion. Claim 22 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 23, Herz teaches:

The computer program as recited in claim 16 wherein the subscriber delivery information comprises a maximum number of promotions to be received within a specified time period. Claim 23 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 24, Herz teaches:

The computer program as recited in claim 16 further comprising a code segment for receiving feedback from the selected subscribers. Claim 24 contains the same limitations as claim 9 therefore the same rejection is applied.

As per claim 25, Herz teaches:

The computer program as recited in claim 16 further comprising:

a code segment for receiving a request to distribute the promotion; and

a code segment for retrieving the promotion and the target subscriber information. Claim 25 contains the same limitations as claim 10 therefore the same rejection is applied.

As per claim 26, Herz teaches:

The computer program as recited in claim 16 wherein the code segment for selecting one or more subscribers comprising:

a code segment for retrieving the subscriber information for the subscriber; and

a code segment for selecting the subscriber when a comparison of the target subscriber information to the subscriber information for the subscriber satisfies one or more rules. Claim 26 contains the same limitations as claim 11 therefore the same rejection is applied.

As per claim 27, Herz teaches:

The computer program as recited in claim 16 further comprising a code segment for repeating the retrieval of the subscriber information and selection of the subscriber until the one or more subscribers are selected. Claim 27 contains the same limitations as claim 12 therefore the same rejection is applied.

As per claim 28, Herz teaches:

The computer program as recited in claim 16 wherein the code segment for obtaining subscriber delivery information further comprises:

a code segment for requesting the subscriber delivery information for each selected subscriber using a subscriber identification for each selected subscriber; and

a code segment for receiving the subscriber delivery information. Claim 28 contains the same limitations as claim 13 therefore the same rejection is applied.

As per claim 30, Herz teaches:

A system for distributing a promotion comprising:

a profile manager;

a subscriber selector communicably connected to the profile manager, the subscriber selector selecting one or more subscribers to receive the promotion based on target subscriber information associated with the promotion and subscriber information associated with each subscriber, and obtaining subscriber delivery information for each of the selected subscribers via the profile manager;

a first database communicably connected to the subscriber selector, the first database storing the target subscriber information;

a second database communicably connected to the subscriber selector, the second database storing the subscriber information;

a third database communicably connected to the profile manager, the third database storing the subscriber delivery information; and

a distributor communicably connected to the subscriber selector, the distributor distributing the promotion to each of the selected subscribers based on the subscriber delivery information for the selected subscriber. Claim 30 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 31, Herz teaches:

The system as recited in claim 30 wherein the target subscriber information comprises one or more target preference categories and a target interest level associated with each target preference category. Claim 31 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 32, Herz teaches:

The system as recited in claim 30 wherein the subscriber information comprises one or more preference categories and a subscriber interest level associated with each preference category. Claim 32 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 33, Herz teaches:

The system as recited in claim 30 wherein the target subscriber information comprises target non-sensitive demographic information. Claim 33 contains the same limitations as claim 4 therefore the same rejection is applied.

As per claim 34, Herz teaches:

The system as recited in claim 30 wherein the subscriber information comprises non-sensitive demographic information about the subscriber. Claim 34 contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 35, Herz teaches:

The system as recited in claim 30 wherein the subscriber delivery information comprises a receiving device type and a receiving device address. Claim 35 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 36, Herz teaches:

The system as recited in claim 30 wherein the subscriber delivery information comprises an acceptable time period to receive the promotion. Claim 36 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 37, Herz teaches:

The system as recited in claim 30 wherein the subscriber delivery information comprises a maximum number of promotions to be received within a specified time period. Claim 37 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 38, Herz teaches:

The system as recited in claim 30 wherein the subscriber selector receives a request to distribute the promotion and retrieves the promotion and the target subscriber information. Claim 38 contains the same limitations as claim 10 therefore the same rejection is applied.

As per claim 39, Herz teaches:

The system as recited in claim 30 wherein the subscriber selector retrieves the subscriber information for the subscriber and selects the subscriber when a comparison of the target subscriber information to the subscriber information for the subscriber satisfies one or more rules. Claim 39 contains the same limitations as claim 11 therefore the same rejection is applied.

As per claim 40, Herz teaches:

The system as recited in claim 30 wherein the subscriber selector requests the subscriber delivery information for each selected subscriber using a subscriber identification for each selected subscriber and receives the subscriber delivery information. Claim 40 contains the same limitations as claim 13 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14, 15, 29 and 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. 6,571,279) in view of Uemura et al (U.S. 6,430,161).

As per claim 14, Herz fails to teaches:

The method as recited in claim 1 wherein the step of distributing the promotion further comprising the steps of creating a message that contains the

promotion and is formatted for a receiving device for each selected subscriber and

sending the message to the receiving device for each selected subscriber if the selected

subscriber has not been sent a specified number of messages within a specified time

period. However, Uemura teaches a system that uses the capacity of the users'

receiving devices to adjust the messages transmitted to the users (see column 4, lines

45 – column 5, line 12). Therefore, it would have been obvious to a person of ordinary

skill in the art at the time the application was made, to know that Herz would use the

capacity of the users' receiving devices to adjust the messages transmitted to the users,

as taught by Uemura. This feature would save time and money, as Herz would only

send messages to users capable of displaying them.

As per claim 15, Herz teaches:

A method for distributing a promotion comprising the steps of:

receiving a request to distribute the promotion;

retrieving the promotion and target subscriber information associated with the

promotion from a first database;

retrieving subscriber information for one or more subscribers from a second

database;

selecting the subscriber when a comparison of target subscriber information to

the subscriber information for the subscriber satisfies one or more rules;

requesting subscriber delivery information for each selected subscriber using a

subscriber identification for each selected subscriber, wherein the subscriber delivery

information is stored on a third database;

receiving the subscriber delivery information;

creating a message that contains the promotion and is formatted for a receiving device for each selected subscriber; and

sending the message to the receiving device for each selected subscriber if the selected subscriber has not been sent a specified number of messages within a specified time period. Claim 15 contains the same limitations as claims 11, 13 and 14 therefore the same rejection is applied.

As per claim 29, Herz and Uemura teach:

The computer program as recited in claim 16 wherein the code segment for distributing the promotion further comprising:

a code segment for creating a message that contains the promotion and is formatted for a receiving device for each selected subscriber; and

a code segment for sending the message to the receiving device for each selected subscriber if the selected subscriber has not been sent a specified number of messages within a specified time period. Claim 29 contains the same limitations as claim 14 therefore the same rejection is applied.

As per claim 41, Herz and Uemura teach:

The system as recited in claim 30 wherein the subscriber selector creates a message that contains the promotion and is formatted for a receiving device for each selected subscriber, and the distributor sends the message to the receiving device for each selected subscriber if the selected subscriber has not been sent a specified

number of messages within a specified time period. Claim 41 contains the same

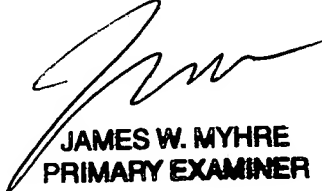limitations as claim 14 therefore the same rejection is applied.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-

5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.   Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
September 4, 2004

JAMES W. MYHRE
PRIMARY EXAMINER